The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 25

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MARTIN KELLY JONES

Appeal No. 2005-0030
Application No. 09/516,288

MAILED

FEB 25 2005

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

ON BRIEF

Before FRANKFORT, MCQUADE, and DIXON, ***Administrative Patent Judges.***
FRANKFORT, ***Administrative Patent Judge.***

DECISION ON APPEAL

This is a decision on appeal from the examiner's rejection of claims 1 through 37, all of the claims pending in the application.

Appellant's invention relates to a package delivery notification system and method for reporting to a recipient when, within a precise time period, a vehicle is expected to deliver a package. Independent claims 1, 5, 12, 16, 24 and 28 are representative of the subject matter on appeal and a copy those claims can be found in the Appendix to appellant's brief.

The prior art references of record relied upon by the examiner in rejecting the claims on appeal are:

Fruchey et al. (Fruchey)	4,297,672	Oct. 27, 1981
Nathanson et al. (Nathanson)	5,122,959	Jun. 16, 1992
Dlugos Sr. et al. (Dlugos)	5,153,842	Oct. 6, 1992
Schmier et al. (Schmier)	6,006,159	Dec. 21, 1999

Hitchcock, Nancy. "The Big Hiccup." April 1996; Apparel Industry Magazine; v57n4 pp 16-28.

Bar Code (anonymous). June 1999; Automatic ID News; v15n7.

In addition to the foregoing prior art references, the examiner has also relied upon applicant's admitted prior art (AAPA) set forth on page 2 of the specification in the "RELATED ART" section.

Claims 1 through 4, 24 through 27 and 36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Schmier in view of Dlugos and AAPA.

Claims 5 through 7, 9, 10, 12 through 19, 21, 28, 29, 31 and 33 stand rejected under 35 U.S.C. § 103(a) as being unpatentable

over Schmier in view of Dlugos and AAPA as applied above, further in view of Hitchcock.

Claims 8 and 30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Schmier in view of Dlugos, AAPA and Hitchcock as applied above, further in view of Bar Code.

Claims 11, 20, 32 and 37 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Schmier in view of Dlugos, AAPA and Hitchcock as applied above, further in view of Fruchey.

Claims 22, 23, 34 and 35 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Schmier in view of Dlugos, AAPA and Hitchcock as applied above, further in view of Nathanson.

Rather than attempt to reiterate the examiner's commentary with regard to the above-noted § 103 rejections and the conflicting viewpoints advanced by appellant and the examiner regarding those rejections, we make reference to the examiner's answer (mailed November 17, 2003) for the reasoning in support of

the rejections, and to appellant's brief (filed August 25, 2003) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellant's specification and claims, to the applied prior art, and to the respective positions articulated by appellant and the examiner. As a consequence of our review, we have made the determination that the above-noted § 103 rejections will not be sustained. Our reasons follow.

In the rejection of claims 1 through 4, 24 through 27 and 36 under 35 U.S.C. § 103(a) as being unpatentable over Schmier in view of Dlugos and AAPA, we note that Schmier discloses a public transit vehicle arrival information system and method for notifying passengers waiting for public transit vehicles of the status of the vehicles, including the projected arrival times of the vehicles at stops. Each of the vehicles in the transit system carries a global position determining device for determining the location of the vehicles along their routes and for communicating

that location information to a central processor/computer. The central processor is programmed to compute and update from the present location of the transit system vehicles and other electronically stored information a transit data table which includes status information for all the vehicles in the system, including the location of scheduled stops and the predicted arrival times of the vehicles at their assigned stops. In addition, the central processor is configured to broadcast the updated transit data tables by wired or wireless transmission throughout the area serviced by the transit system so that such information is available for public access via display devices at the stops, display devices mounted on or in the moving transit vehicles, an automatic telephone access system, and pagers or personal computers.

Dlugos discloses an integrated circuit package label and manifest system wherein an integrated circuit card having a microprocessor, a memory, and input and output devices stores information regarding a parcel and is secured to the parcel to serve as a label. In addition, another aspect of the invention of Dlugos concerns a similar integrated circuit card which stores

manifest data regarding a group of parcels, which card is delivered to a carrier together with the group of parcels. In column 9, lines 19-32, it is noted that

> [a]n automated sorting system, comprising one or more terminals 300 or the like, reads routing information through bar code scanner 308 or through sensor 306, and directs the parcel into an appropriate bin for dispatch to the next point en route. This process may occur at several points before the parcel is delivered. At each sorting point, or at other points along the way, terminals can be used to read parcel identification information from the label so as to track the progress of the parcel through the carrier's system. At those same points or others, the time, place and location of sorting or handling may be written into the label, so that the parcel carries with it a record of its path through the system.

The admitted prior art set forth on page 2 of the specification (AAPA) relates to known package delivery services that guarantee that a package will be delivered at the premises of the recipient on a particular day, or perhaps arrive at the premises before a particular time (e.g., before noon). The specification goes on to note that

> [h]owever, the recipient is not usually aware of the precise time that the package will be delivered. For example, when a package is guaranteed to be delivered before noon on a particular day, the package may arrive at any time before noon (e.g., between approximately 8:30 a.m. and 12:00 p.m.), depending on the route and number of stops made by the delivery vehicle in delivering the package and other packages. Adding to

> the difficulty of estimating when a package may arrive, the route and number of stops made by the same delivery vehicle often changes from day-to-day, depending on the destinations of each of the packages delivered by the delivery vehicle.

Appellant argues, and we strongly agree, that the above-noted prior art applied by the examiner offers no suggestion or motivation for the combination thereof in the manner urged by the examiner, and that even if combined it fails to teach or suggest each and every element of independent claims 1 and 24 on appeal. Even assuming that Schmier is analogous art, a point disputed by appellant, we agree that the examiner's attempted combination of the public transit vehicle arrival notification system of Schmier, the integrated package label and/or manifest system of Dlugos, and the information relating to known package delivery services described on page 2 of appellant's specification (AAPA), and the wholesale changes in the public transit vehicle arrival information system of Schmier resulting therefrom, represent an improper exercise in hindsight reconstruction of the claimed invention based on appellant's own teachings.

The examiner's assertion that the pubic passenger system of Schmier "could easily be modified to solve the problem of

delivering packages" and that "[t]he same concepts, such as notifications, routes and routing schedules, delivery dates, and information access/transmission, could easily be applied to delivering parcels" (answer, page 33) is based totally on speculation and conjecture, and the hindsight afforded the examiner by first having read appellant's disclosure in the present application. In that regard, we note that the mere fact that the prior art could be modified in the manner urged by the examiner would not have made such modification obvious unless the prior art suggested the desirability of the modification. See In re Gordon, 773 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984) and In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992).

In this case, it is our opinion that the examiner has impermissibly drawn from appellant's own teaching and fallen victim to what our reviewing Court has called "the insidious effect of a hindsight syndrome wherein that which only the inventor has taught is used against its teacher." W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed. Cir. 1983).

Since we have determined that the teachings and suggestions found in Schmier, Dlugos and AAPA would not have made the subject matter as a whole of independent claims 1 and 24 on appeal obvious to one of ordinary skill in the art at the time of appellant's invention, we must refuse to sustain the examiner's rejection of those claims under 35 U.S.C. § 103(a). It follows that the examiner's rejection of dependent claims 2 through 4, 25 through 27 and 36 under 35 U.S.C. § 103(a) as being unpatentable over Schmier in view of Dlugos and AAPA will likewise not be sustained.

Regarding the examiner's rejection of claims 5 through 7, 9, 10, 12 through 19, 21, 28, 29, 31 and 33 under 35 U.S.C. § 103(a) as being unpatentable over Schmier in view of Dlugos, the AAPA and Hitchcock, we find nothing in the addition of Hitchcock to change our view expressed above concerning the lack of any teaching, suggestion or motivation in the applied prior art for making wholesale changes in the public transit vehicle arrival information system of Schmier as proposed by the examiner. For that reason, we will not sustain the examiner's rejection of claims 5 through 7, 9, 10, 12 through 19, 21, 28, 29, 31 and 33 under 35 U.S.C. § 103(a).

As for the rejection of dependent claims 8 and 30 under 35 U.S.C. § 103(a) as being unpatentable over Schmier in view of Dlugos, the AAPA, Hitchcock and Bar Code; the rejection of claims 11, 20, 32 and 37 under 35 U.S.C. § 103(a) as being unpatentable over Schmier in view of Dlugos, the AAPA, Hitchcock and Fruchey; and the rejection of claims 22, 23, 34 and 35 under 35 U.S.C. § 103(a) as being unpatentable over Schmier in view of Dlugos, the AAPA, Hitchcock and Nathanson, we have reviewed the added prior art to Fruchey, Nathanson and Bar Code, but find nothing therein that overcomes or provides response for that which we have found lacking in the examiner's proposed basic combination of Schmier in view of Dlugos and the AAPA. Thus, for the reasons already set forth above, we will not sustain the examiner's rejections of dependent claims 8, 11, 20, 22, 23, 30, 32, 34, 35 and 37 under 35 U.S.C. § 103(a).

In light of the foregoing, the decision of the examiner to reject claims 1 through 37 of the present application under 35 U.S.C. § 103(a) is reversed.

In addition to the foregoing, we REMAND this application to the examiner for a consideration of the teachings in Hitchcock (page 3, lines 13-27) and their potential applicability to claims 5-9 on appeal under 35 U.S.C. §§ 102 and/or 103. We also suggest the examiner consider the combined teachings of Hitchcock (pages 1-3) and the information relating to package delivery services noted on page 2 of appellant's specification (AAPA) and the potential applicability of the collective teachings thereof to claims 16-19, 21, 22, 28-31, 33 and 34 on appeal under 35 U.S.C. § 103.

REVERSED AND REMANDED

CHARLES E. FRANKFORT)
Administrative Patent Judge)
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JOHN P. MCQUADE) BOARD OF PATENT
Administrative Patent Judge) APPEALS
) AND
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JOSEPH L. DIXON)
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